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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/275,514 03/24/99 HOLLIMAN

M 42390.P7034

EXAMINER

TM02/1101

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ART UNIT

PAPER NUMBER

2161

DATE MAILED:

11/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/275,514

Applicant(s)

HOLLIMAN ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5. 6) ☐ Other: _____

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The drawings are objected to because:

A) the following errors have been noted in the drawings:

(1) as disclosed between page 15, line 19, and page 16, line 2, "FIG. 11 illustrates a computer 220 ... disc 228 ... (DVD) players, and the like.", fig. 11 lacks "disc 228".

(2) figs. 11, 12 & 14 use reference number 226 to designate different features of the invention, note:

(a) in regard to fig. 11, "CHIPSET I/O 226" as disclosed between page 15, line 19, and page 16, line 2, "FIG. 11 illustrates a computer 220 ... CHIPSET I/O 226 ... (DVD) players, and the like.";

(b) in regard to fig. 12, "LINK 226" as disclosed at page 16, lines 6-18, "Referring to FIG. 12, a ... mechanism 244 and link 226."; and

(c) in regard to fig. 14, "LINK 226" as disclosed at page 18, lines 4-13, "Referring to FIG. 14, a ... from link 226. (There ... between link 226 and descrambling ... by coefficient selection mechanism 246."; which is forbidden by 37 CFR § 1.84(p(4)).

(3) figs. 11 & 15 use reference numbers 236 & 238 to designate different features of the invention, note:

(a) in regard to fig. 11, "REMOTE COMPUTER 236" and "DISPLAY 238" as disclosed between page 15, line 19, and page 16, line 2, "FIG. 11 illustrates a computer 220 ... computer 236 ...). Computer 236 ... display 238 ... (DVD) players, and the like."; and

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(b) in regard to fig. 15, "COEFFICIENT SELECTION 238" and
"STRENGTH PARAMETER 238" as seen in fig. 15;

which is forbidden by 37 CFR § 1.84(p(4)).

Correction is required.

2.1 Applicant is required to submit a proposed drawing correction in response to this Office action (37 CFR § 1.121(d)). However, correction of the noted defect can be deferred until the application is allowed by the examiner.

3. The disclosure is objected to because of the following informalities:

A) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 100 of fig. 3 between page 6, line 16, and page 8, line 11,

"Referring to FIGS, 1-3, a ... the protection of the protected segment.";

(b) 230 of fig. 11 between page 15, line 19, and page 16, line 2,

"FIG. 11 illustrates a computer 220 ... (DVD) players, and the like.";

(c) 316 of fig. 17 at page 21, lines 12-21, "As an example, FIG.

17 illustrates a ... or only those that change order.";

(d) 328 & 336 of fig. 18 at page 21, lines 22-28, "FIG. 18

illustrates a ... are read out in the original order.";

as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e). It is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) from fig. 4 and the context of the paragraph at page 8, lines 12-17,

"FIG. 4 illustrates ... Mechanism 102 may ... content into segments of a group."; at the line 5 of this paragraph "102" should be -120--.

(2) from fig. 11 and the context of the paragraph between page 15, line

19, and page 16, line 2, "FIG. 11 illustrates a computer 220 ... 228. Memory

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222, memory 228, and disc 228 ... (DVD) players, and the like.”, at line 2 of this paragraph, “Memory 222” should be –Memory 224--.

(3) from fig. 11 and the context of the paragraph between page 15, line 19, and page 16, line 2, “FIG. 11 illustrates a computer 220 ... 228. Memory 222, memory 228, and disc 228 ... (DVD) players, and the like.”, at line 3 of this paragraph, “disc 228” should be –disc 230--.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

5. Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claim 10, this claim lacks antecedent support in either claim 1 or claim 8 from which it depends for protecting video signal in the MPEG format. Note the recitation of video signals in claim 9.

5.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1 Claims 1, 9, 11, 12, 19, 24, 25, 26 & 28 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Thomas et al (5,425,100).

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6.1.1 In regard to claims 1, 9, 11, 12, 19, 24, 25, 26 & 28, Thomas et al ('100) disclose the breaking up of content, e.g. a video and audio signal, into segments. The segments are then selectively protected by encoding/scrambling the segments. Finally, the encoded information is transmitted to the user. The user then may use the correct key to decrypt the encrypted segments of the transmitted content so that the user may use the content.

6.1.2 It is noted that in order for the segments of Thomas et al ('100) to be selectively encrypted, the system of Thomas et al ('100) must contain the necessary hardware and software to permit the user to perform the functions of selecting and storing the segments of content.

6.1.3 It is noted that the system of Thomas et al ('100) is computerized and hence requires a control program to be stored in a machine readable memory to control the operation of the system of Thomas et al ('100).

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 2-8, 10, 13-18, 20-23, 27 & 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas et al (5,425,100) as applied to claims 1, 9, 11, 12, 19, 24, 25, 26 & 28 and further in view of an obvious variations.

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7.1.1 In regard to the type of encryption/scrambling used in claims 2, 6, 7, 13, 14, 21, 22 & 23, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable type of encryption could be used absent applicant's showing of new and unexpected results from the use of a particular type encryption. Further, since decrypting content that has not been encrypted would obscure the content, i.e. scramble the content, it would have been obvious to one of ordinary skill at the time the invention was made that type of encryption used to encrypt one or more of the segments of the content must be provided and identified to the user in any suitable manner before the encryption may be reversed.

7.1.2 In regard to the nature of the key used in the encryption/scrambling as recited in claims 3, 4, 15, 20, 27 & 29, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable information could be used as the encryption key absent applicant's showing of new and unexpected results from the use of a particular type information as the encryption key.

7.1.3 In regard to the selective protection of claim 5, note the selective encryption of Thomas et al ('100).

7.1.4 In regard to the nature of the key used during playback as recited in claim 8, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key to encrypt and decrypt the protected content, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable information could be used as the encryption key for encrypting and decrypting the content absent applicant's showing of new and unexpected results from the use of a particular type information as the encryption key.

8. To complete the record, applicant must supply the standards mentioned at:

- (a) page 14, lines 16-23, "The invention is not ... than MPEG may be used.";
- and
- (b) page 19, lines 15-27, "The key may be used in ... of coefficients for sign inversion.";

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as well as a properly completed PTO-1449.

9. The examiner has cited prior art of interest, for example:

A) either Maeda et al (JP 62-79578) or Newby et al (6,108,422) which disclose the encryption of segments of content.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

10/24/01


Edward R. Cosimano
Primary Examiner A.U. 2161